

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* SHINGO KATO, MASASHI MIYAZAKI,  
HIROSHIGE OCHIMIZU, and MASAMI TADA

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Appeal 2012-010799  
Application 12/475,549  
Technology Center 2400

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Before ALLEN R. MacDONALD, JASON V. MORGAN, and  
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1–11. We have jurisdiction under 35 U.S.C. § 6(b).

### *Exemplary Claims*

Exemplary claims 1 and 11 under appeal read as follows (emphasis added):

1. A computer system that supports setting of a destination address of an email, the system comprising:

a detecting section of the computer system coupled to a mail server that detects a destination address of an email as a primary address in response to a user's input; and

a display section of the computer system that displays a message before sending the email to the mail server when receiving status information, from a recipient of the email, ***indicating that the email has not been read by the recipient for a predetermined period.***

11. A program product for a computer that supports the setting of the destination of an email, the program product comprising a ***computer usable storage medium storing*** computer usable program code, the computer usable storage medium storing:

computer usable program code for detecting the destination address of the email as a primary address according to an operation of a user for entering the destination address; and;

computer usable program code for displaying, when the primary address detected by the detecting section has status information indicating the status of the email, a message indicating that the email has not been for a specified period.

### *Rejections on Appeal*

1. The Examiner rejected claim 11 under 35 U.S.C. § 101 as the claimed invention is directed to non-statutory subject matter.

2. The Examiner rejected claims 1–11 under 35 U.S.C. § 112, second paragraph, as being indefinite.<sup>1</sup>

3. The Examiner rejected claims 1–11 under 35 U.S.C. § 102(b) as being anticipated by Keohane (US 2008/0104177 A1; May 1, 2008).<sup>2</sup>

*Appellants' Contentions*

1. Appellants contend the Examiner erred in rejecting claim 11 under 35 U.S.C. § 101 because:

Appellants' Specification does not list a carrier wave as a computer usable storage medium. Rather, Appellants' specification distinguishes a propagation medium from a non-exhaustive list of storage media at Paragraph [0022]. In this regard, Appellants' examples listed in Paragraph [0156] recite storage media including a magnetic disk and an optical disk, such as a compact disk (CDROM) and DVD.

(App. Br. 9).

2. Further, Appellants contend the Examiner erred in rejecting claim 11 because the statutory nature of a claim reciting a “computer usable storage medium” is supported both by numerous Board decisions. (App. Br. 5–9).

3. Appellants contend the Examiner erred in rejecting claims 1–11 under 35 U.S.C. § 112, second paragraph, for the reasons set forth at pages 10–12 of the Appeal Brief (and Reply Br. 5). Particularly, Appellants allege

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<sup>1</sup> Separate patentability is not argued for claims 2–11. Except for our ultimate decision, claims 2–11 are not discussed further herein with respect to this contention.

<sup>2</sup> Separate patentability is not argued for claims 2–11. Except for our ultimate decision, claims 2–11 are not discussed further herein with respect to this contention.

“Examiner continues in Examiner’s failure to articulate a proper rejection for indefiniteness.” (App. Br. 11). Further, Appellants point out that “A claim is not ‘indefinite’ simply because it is hard to understand when viewed without benefit of the specification.” (App. Br. 11–12)(quoting *S3 Inc. v. nVIDIA Corp.*, 59 USPQ2d 1745 (Fed. Cir. 2001)).

4. Appellants contend the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(b) because:

[C]laims 1, 9, 10 and 11 relate to the warning of a composer of e-mail that an addressee of an e-mail message has not previously read an e-mail message for a threshold period of time (indicating an unlikelihood that the addressee will read any further e-mail message in a timely manner).  
(App. Br. 13).

Notwithstanding, at page 4 of the Final Office Action, Examiner refers to paragraph [0030], lines 19 through 27 of Keohane for the same teaching and notes that the “out-of-office notification” of Keohane is the same as indicating that email has not been read for a specified period of time. Respectfully, as noted previously in the Amendment, Appellants disagree. Applicants recognize ***that much of the Patent Application addresses an “out-of-office notification” scenario*** in warning a composer of an e-mail message of the potential unavailability of a designated recipient of an e-mail message. However, as noted by Appellants in the Amendment, the second to last paragraph of the Summary of the Invention portion of Appellants’ specification states with specificity:

According to the present invention, there is provided a method for supporting the setting of the destination of an email. The method includes the steps of detecting the destination address of the email as a primary address according to an operation of a user for entering the destination address; and when the primary address detected by the detecting section has status information

indicating the status of the email, displaying a message indicating that the email is not read for a specified period.

Further, Appellants noted in the Amendment that Appellants' claim language of claims 1, 9, 10 and 11 ***is directed specifically to this disclosed embodiment*** of Appellants' invention.

As previously argued, ***the fact that an “out-of-office” notification is provided, has no bearing upon whether or not a prior e-mail message has been read.*** To wit, the traditional “out-of-office” notification does not speak to the status of any e-mail, but to the status of a person.

(App. Br. 13–14)(emphasis added).

### *Issues on Appeal*

Did the Examiner err in rejecting claim 11 as being directed to non-statutory subject matter?

Did the Examiner err in rejecting the claims 1–11 because these claims do comply with the requirement under 35 U.S.C. § 112, second paragraph for “particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention?”

Did the Examiner err in rejecting claims 1–11 as being anticipated under 35 U.S.C. § 102(b) because Keohane fails to describe “indicating that the email has not been read by the recipient for a predetermined period” as argued by Appellants?

### ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments that the Examiner has erred.

*35 U.S.C. § 101*

As to Appellants' above contention 1, we disagree. We find to be mistaken Appellants' statement that "Appellants' Specification does not list a carrier wave as a computer usable storage medium." (App. Br 9). To the contrary, Appellants' Specification states that transmission media can be used to store the computer program.

The *computer program may be stored in a computer-readable medium* for provision. *Examples of the medium include* an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system (unit or device) or *transmission media*. (Spec. [0156])(emphasis added). We deem "computer-readable medium" and "computer usable medium" to be equivalent.

In claim 11, the recited "computer usable storage medium" is not claimed as non-transitory, and the disclosure does not expressly and unambiguously limit that medium to solely non-transitory forms via a definition or similar limiting language. Therefore, the medium encompasses transitory forms and is ineligible under §101. Accordingly, Appellants' evidence and argument do not persuade us of any error in the Examiner's reading of the contested limitation as encompassing non-statutory subject matter. Therefore, we sustain the Examiner's non-statutory subject matter rejection of independent claim 11.

As to Appellants' above contention 2, we disagree. Absent Appellants acting to define a term (as we have found directly above), the first step in claim construction is to determine the ordinary and customary meaning, if any, that would be attributed to the term by those skilled in the art. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001). A term's ordinary meaning is that which it assumes in the field of the

invention, *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299 (Fed. Cir. 1999).

The intellectual property industry has established a broader meaning for the claim term “computer readable storage medium” in the area of computer related patent claims so as to encompass transitory media such as signals or carrier waves. A full discussion of this broader meaning is set forth in *Ex parte Mewherter*,<sup>3</sup> 107 USPQ2d 1857, 2013 WL 4477509 (PTAB 2013) (precedential) (holding recited machine-readable storage medium ineligible under § 101 where the applicant does not limit the computer readable storage to non-transitory forms). Appellants’ arguments directed to *Ex parte Mehta* (and other Board decisions) are unavailing and such arguments were fully addressed by the decision in *Mewherter*.

*35 U.S.C. § 112*

As to Appellants’ above contention 3, we disagree. We agree with the Examiner that claim 1 is indefinite for the reasons set forth by the Examiner at pages 3 and 9 of the Final rejection.

*35 U.S.C. § 102*

As to Appellants’ above contention 4, we disagree with Appellants’ construction of the “indicating that the email has not been read by the recipient” limitation in the claims. We agree with the Examiner (Final 3) that “indicating that the email has not been read by the recipient” limitation in the claims (and similar language in the Brief Summary of Appellants’ Specification) is supposed to be read as “indicating that the email will not be read by the recipient” (i.e., an “out-of-office notification”).

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<sup>3</sup> *Ex parte Mewherter* involved the same assignee and legal representative as this appeal.

We reach this conclusion for plural reasons: (1) the application before us is a translation from Japanese; (2) every embodiment in Appellants' Detailed Description is consistent with the Examiner's construction and inconsistent with Appellants' interpretation; and (3) although Appellants argue that the "indicating that the email has not been read by the recipient" claim limitation is not an "out-of-office" notification function as argued by the Examiner, Appellants themselves point to (App. Br. 3:3–7) an "out-of-office" notification function (Spec. [0091]) as support for the claim limitation.

We are not persuaded by Appellants' statement that their Summary sets forth a disclosed embodiment which is consistent with Appellants' claim construction primarily because (a) Appellants' argument is not consistent with the portion of their Specification they rely on to support the argued claim limitation and (b) Appellants' argued claim construction excludes every embodiment in Appellants' Detailed Description. *In re Papst Licensing Digital Camera Patent Litigation.*, \_\_\_ F.3d \_\_\_ (Fed. Cir. February 2, 2015) ("We do not generally construe the claims of a patent to exclude a preferred embodiment." (citation omitted)). *Epos Technologies Ltd. v. Pegasus Technologies Ltd.*, 766 F.3d 1338, 1347 (Fed. Cir. 2014) ("[A] claim construction that excludes a preferred embodiment ... is rarely, if ever correct and would require highly persuasive evidentiary support." (Citation omitted)).

We conclude that Appellants are attempting to turn poor translation into invention even though Appellants' Detailed Description fails to support Appellants' recently discovered interpretation of the claim.



### CONCLUSIONS

- (1) The Examiner did not err in rejecting claim 11 under 35 U.S.C. § 101, as being directed to non-statutory subject matter.
- (2) The Examiner did not err in rejecting claims 1–11 as being indefinite under 35 U.S.C. § 112, second paragraph.
- (3) The Examiner has not erred in rejecting claims 1–11 as being anticipated under 35 U.S.C. § 102(b).
- (4) Claims 1–11 are not patentable.

### DECISION

The Examiner's rejection of claim 11 as being directed to non-statutory subject matter under 35 U.S.C. § 101, is affirmed.

The Examiner's rejection of claims 1–11 as being indefinite under 35 U.S.C. § 112, second paragraph, is affirmed.

The Examiner's rejection of claims 1–11 as being anticipated under 35 U.S.C. § 102(b) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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